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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,960	11/28/2000	John Edward Cronin	IPCG-043	8198

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Attention: Aliko K. Collins, Ph.D.
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EXAMINER

DODDS, HAROLD E

ART UNIT	PAPER NUMBER
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2168

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,960

Applicant(s)

CRONIN ET AL.

Examiner

Harold E. Dodds, Jr.

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-53, 55-66, 68-78, 80-91 and 93-103 is/are rejected.
- 7) ☐ Claim(s) 54, 67, 79 and 92 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>031506</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 January 2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 50, 51, 55-57, 63, 64, 68-70, 75, 76, 80-82, 87-89, and 93-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent No. 6,499,026) and Paulsen, Jr. et al. (U.S. Patent No. 6,278,917).

4. Rivette renders obvious independent claim 50 as follows:

"...developing a set of user-defined fields..." at col. 19, lines 24-28.

"...said set of user-defined fields being distinct..." at col. 19, lines 24-28 and col. 23, lines 23-25.

"...searching the first database..." at col. 25, lines 47-50.

"...so as to retrieve a plurality of retrieved documents from among the plurality of documents..." at col. 25, lines 47-50.

"...reading each of said plurality of retrieved documents..." at col. 15, lines 58-60 and col. 25, lines 47-50.

"...so as to extract from each of said plurality of retrieved documents..." at col. 101, lines 10-13 and col. 25, lines 47-50.

"...a user-defined field value for at least one user-defined field of said set of user-defined fields..." at col. 19, lines 24-28, col. 117, lines 61-67, and col. 118, lines 1-3.

"...so as to obtain a plurality of user-defined field values..." at col. 19, lines 24-28, col. 117, lines 61-67, and col. 118, lines 1-3.

"...entering said plurality of user-defined value extracted..." at col. 117, lines 61-67, col. 118, lines 1-3, and col. 101, lines 10-13.

"...into a second database..." at col. 25, lines 47-50.

"...and entering the ones of the plurality of search field values..." at col. 20, lines 58-60, col. 19, lines 24-28, col. 117, lines 61-67, and col. 118, lines 1-3.

"...corresponding to said plurality of retrieved documents into said second database..." at col. 25, lines 47-50.

Rivette does not teach the developing of search arguments and the providing information related to a user's interest.

5. However, Paulsen teaches the developing of search arguments for information related to user's interests as follows:

"...developing a set of search arguments..." at col. 9, lines 33-37 and col. 15, lines 2-6.

"...relating to one or more interests of a user..." at col. 1, lines 53-56.

"...relating to said one or more interests..." at col. 1, lines 53-56.

"...from said set of search arguments..." at col. 9, lines 33-37 and col. 15, lines 2-6.

"...using at least some of said set of search arguments..." at 9, lines 33-37 and col. 15, lines 2-6.

It would have been obvious to one of ordinary skill at the time of the invention to combine Paulsen with Rivette to provide developing of search arguments for information related to user's interests in order to provide a means of retrieving relevant information from databases. Rivette and Paulsen teach the use of related systems. They teach the use of computers, the use of databases, the use of networks, the use of documents, the use of values, the use of information, the searching for information, and the retrieval of information. Rivette provides for the search and retrieval of documents from databases, the use of fields for data, the use of values, and the use of extraction and Paulsen

Art Unit: 2168

develops search arguments for information related to user's interests. For independent claim 50, the terms "build" and "different" have been used to suggest the terms "develop" and "distinct", respectively.

6. As per independent claims 63, 75, and 87, the "...receiving a set of search arguments relating to one or more interests of a user..." is taught by Paulsen at col. 15, lines 39-44, col. 15, lines 2-6, and col. 1, lines 53-56, the "...receiving a set of user-defined fields..." is taught by Rivette at col. 50, lines 2-4 and col. 19, lines 24-28 relating to said one or more interests..." is taught by Paulsen at col. 1, lines 53-56, the "...said set of user-defined fields being distinct..." is taught by Rivette at col. 19, lines 24-28 and col. 23, lines 23-25, from said set of search arguments..." is taught by Paulsen at col. 9, lines 33-37 and col. 15, lines 2-6, the "...searching the first database..." is taught by Rivette at col. 25, lines 47-50, using at least some of said set of search arguments..." is taught by Paulsen at col. 9, lines 33-37 and col. 15, lines 2-6, the "...so as to retrieve a plurality of retrieved documents from the plurality of documents..." is taught by Rivette at col. 25, lines 47-50, the "...receiving, for each of said plurality of retrieved documents..." is taught by Rivette at col. 50, lines 2-4 and col. 25, lines 47-50,

Art Unit: 2168

the "...user-defined field value for at least one user-defined field of said set of user-defined fields...", is taught by Rivette at col. 19, lines 24-28, col. 117, lines 61-67, and col. 118, lines 1-3,

the "...so as to receive a plurality of user-defined field values...", is taught by Rivette at col. 50, lines 2-4, col. 19, lines 24-28, col. 117, lines 61-67, and col. 118, lines 1-3,

the "...said plurality of user-defined field values...", is taught by Rivette at col. 19, lines 24-28, col. 117, lines 61-67, and col. 118, lines 1-3,

the "...having been extracted from said plurality of retrieved documents...", is taught by Rivette at col. 101, lines 10-13 and col. 25, lines 47-50,

the "...entering said plurality of user-defined values received...", is taught by Rivette at col. 117, lines 61-67, col. 118, lines 1-3, and col. 50, lines 2-4,

the "...into a second database...", is taught by Rivette at col. 25, lines 47-50,

the "...entering the plurality of search field values...", is taught by Rivette at col. 20, lines 58-60, col. 19, lines 24-28, col. 117, lines 61-67, and col. 118, lines 1-3,

and the "...into said second database...", is taught by Rivette at col. 25, lines 47-50.

7. As per claims 51, 64, 76, and 89, the "...step of filtering said plurality of retrieved documents...", is taught by Rivette at col. 60, lines 50-52 and col. 25, lines 47-50,

the "...based on at least some of said set of search arguments...", is taught by Paulsen at col. 9, lines 33-37 and col. 15, lines 2-6,

the "...so as to obtain a refined set of documents...", is taught by Paulsen at col. 15, lines 51-55,

Art Unit: 2168

and the "...being performed relative to said refined set of documents..." is taught by Paulsen at col. 15, lines 51-55.

8. As per claims 55, 68, 80, and 93, the "...step of associating, for each of said plurality of retrieved documents..." is taught by Rivette at col. 49, lines 12-16 and col. 25, lines 47-50

and the "...weight with each of at least some of said plurality of user-defined fields..." is taught by Rivette at col. 99, lines 22-28 and col. 19, lines 24-28.

For claims 55, 68, 80, and 93 the term "count" is used to suggest the term "weight".

9. As per claims 56, 69, 81, and 94, the "...step of entering said weights..." is taught by Rivette at col. 117, lines 61-67 and col. 99, lines 22-28

and the "...into said second database..." is taught by Rivette at col. 25, lines 47-50.

10. As per claims 57, 70, 82, and 95, the "...step of tallying said weights..." is taught by Rivette at col. 99, lines 22-28

and the "...for each of said plurality of retrieved documents..." is taught by Rivette at col. 25, lines 47-50.

For claims 57, 70, 82, and 93, the term "count" is used to suggest the term "tally the weight".

11. As per claim 88, the "...said second database is contained in said computer..." is taught by Rivette at col. 40, lines 13-16.

12. Claims 52, 53, 65, 66, 77, 78, 90, and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette and Paulsen as applied to the claims above, and further in view of Chen et al. (U.S. Patent No. 6,728,752).

As per claims 52, 65, 77, and 90, the "...and assigning each of said plurality of retrieved documents...", is taught by Rivette at col. 13, lines 55-57 and col. 25, lines 47-50, but the "...steps of forming a plurality of HLA clusters..." and the "...to one of said plurality of high level of abstraction (HLA) clusters..." are not taught by either Rivette or Paulsen.

However, Chen teaches the use of high level abstraction clusters as follows:

"The "Clustering Report" 2410 contains the most characteristic keywords 2412 across all documents for the user cluster. This enables quick access to a high level abstraction of this modality while simultaneously viewing other properties..." at col. 30, lines 13-17.

It would have been obvious to one of ordinary skill at the time of the invention to combine Chen with Rivette and Paulsen to provide high level abstraction clusters in order to provide simultaneous viewing of this representation of the cluster of documents with other properties of the documents and obtain greater user acceptance of the system. Rivette, Paulsen, and Chen teach the use of related systems. They teach the use of computers, the use of databases, the use of networks, the use of documents, the use of fields, the use of information, the searching for information, and the retrieval of information and Rivette and Chen teach the use of values and the use of clusters. Rivette provides for the search and retrieval of documents from databases, the use of fields for data, the use of values, and the use of extraction, Paulsen develops search arguments for information related to user's interests, and Chen provides high level abstraction clusters.

13. As per claims 53, 66, 78, and 91, each of said plurality of HLA clusters...,
is taught by Chen at col. 30, lines 13-17,
the "...has a corresponding cluster identifier...", is taught by Chen at col. 36, lines 41-45,
the "...and the method further comprises the step of entering into said second database for each of said plurality of retrieved documents...", is taught by Rivette at col. 117, lines 61-67 and col. 25, lines 47-50,
and the "...one of said cluster identifiers...", is taught by Chen at col. 36, lines 41-45.

14. Claims 58-62, 71-74, 83-86, 96, and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette and Paulsen as applied to the claims above, and further in view of Bollay (U.S. Patent No. 6,457,009).

As per claim 58, the "...includes the step of at least partially populating a first input form...", is not taught by either Rivette or Paulsen.

However, Bollay teaches the use of partial population and the use of input forms as follows:

"Local browser software populates a specific search form peculiar to a given remote database by utilizing the translations as embodied in JavaScript code..." at col. 2, lines 51-54.

"...It will be understood by those skilled in the art that a blank, or partially blank, FORM may be displayed; that is, a form that does not set forth field names of the fields that a user must fill in..." at col. 5, lines 21-24.

"...The software displays 302 an HTML data input form in a first window of an Internet browser..." at col. 5, lines 43-45.

It would have been obvious to one of ordinary skill at the time of the invention to combine Bollay with Rivette and Paulsen to provide partially populated input forms in order to provide input forms with known parameters already in the forms to reduce the amount of user input required, minimize the amount of errors made in the input, and save the users data entry time. Rivette, Paulsen, and Bollay teach the use of related systems. They teach the use of computers, the use of databases, the use of documents, the use of fields, the use of information, the searching for information, and the retrieval of information and Rivette and Bollay teach the use of values. Rivette provides for the search and retrieval of documents from databases, the use of fields for data, the use of values, and the use of extraction, Paulsen develops search arguments for information related to user's interests, and Bollay provides partially populated input forms.

15. As per claim 59, the "...step of at least partially populating said first input form..." is taught by Bollay at col. 2, lines 51-54, col. 5, lines 21-24, and col. 5, lines 43-45, the "...comprises populating said first input form..." is taught by Bollay at col. 2, lines 51-54 and col. 5, lines 43-45, and the "...with known documents already known to the user..." is taught by Rivette at col. 115, lines 22-27.

16. As per claim 60, the "...step of at least partially populating a second input form..." is taught by Bollay at col. 2, lines 51-54, col. 5, lines 21-24, and col. 5, lines 43-45.

Art Unit: 2168

17. As per claim 61, the "...at least partially populating said second input form...", is taught by Bollay at col. 2, lines 51-54, col. 5, lines 21-24, and col. 5, lines 43-45,
the "...includes populating said second input form...", is taught by Bollay at col. 2, lines 51-54 and col. 5, lines 43-45,
the "...with answers to questions...", is taught by Bollay at col. 1, lines 64-65,
and the "...relating to a business of the user...", is taught by Rivette at col. 36, lines 36-39.

18. As per claim 62, the "...assigning weights...", is taught by Rivette at col. 99, lines 22-28
and the "...to at least some of said answers...", is taught by Bollay at col. 1, lines 64-65.

19. As per claims 71, 83, and 96, the "...of presenting the user with a first input form...", is taught by Bollay at col. 5, lines 21-24 and col. 5, lines 43-45
and the "...for developing said set of search arguments...", is taught by Paulsen at col. 9, lines 33-37 and col. 15, lines 2-6.

20. As per claims 72, 84, and 97, the "...of presenting the user with a second input form...", is taught by Bollay col. 5, lines 21-24 and col. 5, lines 43-45
and the "...for developing said set of user-defined fields...", is taught by Rivette at col. 19, lines 24-28.

21. As per claims 73 and 85, the "...receiving via said second input form...", is taught by Bollay at col. 8, lines 4-5 and col. 5, lines 43-45,
the "...answers a plurality of questions...", is taught by Bollay at col. 1, lines 64-65,

and the "...relating to a business of the user..." is taught by Rivette at col. 36, lines 36-39.

22. As per claim 74 and 86, the "...receiving via said second input form..." is taught by Bollay at col. 8, lines 4-5 and col. 5, lines 43-45, the "...weights..." is taught by Rivette at col. 99, lines 22-28, and the "...for at least some of said answers..." is taught by Bollay at col. 1, lines 64-65.

23. Claims 98 and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al. (U.S. Patent No. 6,499,026) and Hunter et al. (U.S. Patent No. 6,298,327).

24. Rivette renders obvious independent claim 98 by the following:
"...retrieving a plurality of patent documents from a first database..." at col. 25, lines 47-50.
"...each of said plurality of patent documents disclosing at least one invention..." at col. 25, lines 47-50 and col. 26, lines 61-62.
"...reviewing each of said plurality of patent documents..." at col. 108, lines 30-32 and col. 25, lines 47-50.
"...so as to determine for each of said plurality of patent documents..." at col. 107, lines 13-18 and col. 25, lines 47-50.
"...corresponding to that one of said plurality of patent documents..." at col. 25, lines 47-50.

"...corresponds to a respective one of said plurality of patent documents..." at col. 25, lines 47-50.

Rivette does not teach the use of the use of statements of problems solved.

25. However, Hunter teaches the use of statements of problems solved as follows:

"...a problem solved by said at least one invention..." at col. 13, lines 21-25.

"...preparing a problem solved statement for each said problem solved..." at col. 13, lines 21-25.

"...and entering each said problem solved statement into a second database..." at col. 4, lines 17-20, col. 13, lines 21-25, and col. 5, lines 41-49.

"...so that each said problem solved statement..." at col. 13, lines 21-25.

It would have been obvious to one of ordinary skill at the time of the invention to combine Hunter with Rivette to provide problems solved statements in order to provide statements that paraphrase and amplify the broadest claims. Rivette and Hunter teach the use of related systems. They teach the use of computers, the use of databases, the use of networks, the use of information, the searching for information, the retrieval of information, the use of patents, and the use of documents. Rivette provides for patent documents, inventions, and databases and Hunter provides problems solved statements.

26. As per claim 101, the "...first set of computer-executable instructions for presenting a user..." is taught by Hunter at col. 7, lines 60-64 and col. 25, lines 47-50,

Art Unit: 2168

the "...with a plurality of front page data input fields..." is taught by Rivette at col. 19, lines 10-20 and col. 19, lines 24-28,

the "...and labeling said plurality of front page data input fields..." is taught by Rivette at col. 63, lines 43-47, col. 19, lines 10-20, and col. 19, lines 24-28,

the "...with a plurality of first indicia that indicates that said plurality of front page data input fields..." is taught by Rivette at col. 4, lines 46-48, col. 19, lines 10-20, and col. 19, lines 24-28,

the "...are for receiving the front page data..." is taught by Rivette at col. 26, lines 42-45 and col. 19, lines 10-20,

the "...second set of computer-executable instructions for storing in a database..." is taught by Hunter at col. 7, lines 60-64 and col. 5, lines 41-49,

the "...front page data input into said plurality of front page data input fields..." is taught by Rivette at col. 19, lines 10-20 and col. 19, lines 24-28,

the "...third set of computer-executable instructions for presenting the user..." is taught by Hunter at col. 7, lines 60-64 and col. 5, lines 50-53,

the "...with a problem solved statement input field..." is taught by Hunter at col. 13, lines 21-25, col. 29, lines 44-45, and col. 18, lines 10-12,

the "...and labeling said problem solved statement input field with indicia that indicates that said problem solved statement input field..." is taught by Hunter at col. 24, lines 50-53, col. 13, lines 21-25, col. 29, lines 44-45, col. 18, lines 10-12, and col. 6, lines 58-59,

the "...is for receiving a problem solved statement..." is taught by Hunter at col. 3, lines 12-14 and col. 13, lines 21-25,

the "...extracted from a patent document of the group of patent documents..." is taught by Rivette at col. 60, lines 8-15, col. 25, lines 47-50, and col. 28, lines 65-67,

and the "...and a fourth set of computer-executable instructions for storing in said database said problem solved statement....," is taught by Hunter at col. 7, lines 60-64, col. 5, lines 41-49, and col. 13, lines 21-25.

For claim 101 the term "designate" is used to suggest the term "label".

27. Claims 99 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette and Hunter as applied to claims 98 and 101 above respectively, and further in view of Lautenheiser et al. (U.S. Patent No. 6,728,693).

As per claim 99, the "...patent documents in the group of patent documents are owned..." is taught by Rivette at col. 112, lines 18-24, col. 25, lines 47-50, and col. 28, lines 65-67,

the "...by at least one business competitor..." is taught by Rivette at col. 23, lines 39-43,

the "...and the method further comprises the steps of retrieving each said problem solved statement from said second database....," is taught by Hunter at col. 3, lines 12-14, col. 13, lines 21-25, and col. 5, lines 41-49,

the "...and utilizing each said problem solved statement to perform at least one of..." is taught by Hunter at col. 13, lines 51-53, col. 15, lines 37-40, col. 13, lines 21-25, and col. 26, lines 35-38,

but the "...patent opportunity analysis..."

and the "...patent threat analysis...", are not taught by either Rivette or Hunter.

However, Lautenheiser teaches the use of opportunity and threat analyses as follows:

"...The user selects one or more surveys and request a strength, weakness, opportunity or threat analysis..." at col. 27, lines 65-67.

It would have been obvious to one of ordinary skill at the time of the invention to combine Lautenheiser with Rivette and Hunter to perform comparisons between a business and its competitors in order to provide information on the relative strengths and weaknesses of related patents. These comparisons may be performed using opportunity or threat analysis, which are common tools used by industry for such comparisons. Rivette, Hunter, and Lautenheiser teach the use of related systems. They teach the use of computers, the use of databases, the use of networks, the use of information, the searching for information, and the retrieval of information and Hunter, and Lautenheiser teach the use of the recognition of problems and the use of statements. Rivette provides for patent documents, inventions, and databases, Hunter provides problems solved statements, and Lautenheiser provides opportunity analysis and threat analysis.

28. As per claim 102, the "...patent documents in the group of patent documents are owned...", is taught by Rivette at col. 112, lines 18-24, col. 25, lines 47-50, and col. 28, lines 65-67,

Art Unit: 2168

the "...by at least one business competitor..." is taught by Rivette at col. 23, lines 39-43,

the "...and said computer-executable instructions further comprise a fifth set of computer-executable instructions for retrieving each said problem solved statement from said database..." is taught by Hunter at col. 7, lines 60-64, col. 3, lines 12-14, col. 13, lines 21-25, and col. 5, lines 41-49,

the "...and for performing at least one of..." is taught by Hunter col. 26, lines 35-38,

the "...patent opportunity analysis and a patent threat analysis..." is taught by Lautenheiser at col. 27, lines 65-67,

and the "...using said problem solved statement..." is taught by Hunter at col. 15, lines 34-40 and col. 13, lines 21-25.

29. Claims 100 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette and Hunter as applied to claims 98 and 101 above respectively, and further in view of Onishi et al. (U.S. Patent No. 6,154,720).

As per claim 100, the "...with each said problem solved statement..." is taught by Hunter at col. 13, lines 21-25,

the "...into said second database..." is taught by Hunter at col. 5, lines 41-49,

the "...is correlated with a corresponding respective said problem solved statement..." is taught by Hunter at col. 17, lines 15-16, col. 15, lines 34-40, and col. 13, lines 21-25,

but the "...associating a weight of importance..."

the "...and entering each said weight of importance..."

Art Unit: 2168

and the "...so that said weight of importance..." are not taught by either Rivette or Hunter.

However Onishi teaches the use of weights of importance as follows:

"...The semantic features forming the semantic feature string of each set are each given weight information representing the significance, or degree of importance, of the corresponding semantic feature in the input conversational sentence..." at col. 22, lines 36-39.

It would have been obvious to one of ordinary skill at the time of the invention to combine Onishi with Rivette and Hunter to provide weights of importance in order to provide a means of ranking importance of the problems solved and gain greater acceptance with prospective users. Rivette, Hunter, and Onishi teach the use of related systems. They teach the use of computers, the use of databases, the use of fields, the use of information, and the searching for information and Hunter and Onishi teach the recognition of problems. Rivette provides for patent documents, inventions, and databases, Hunter provides problems solved statements, and Onishi provides weights of importance.

30. As per claim 103, the "...associating a weight of importance..." is taught by Onishi at col. 22, lines 36-39, the "...with said problem solved statement..." is taught by Hunter at col. 13, lines 21-25, the "...and said computer-executable instructions comprise a sixth set of computer-executable instructions for presenting the user..." is taught by Hunter 7, lines 60-64, col. 18, lines 16-18, and col. 22, lines 4-6,

Art Unit: 2168

the "...with a weight of importance input field..." is taught by Onishi at col. 22, lines 36-39 and col. 37, lines 47-52,

the "...and labeling..." is taught by Hunter at col. 24, lines 50-53,

the "...said problem weight of importance input field..." is taught by Onishi at col. 65, lines 54-55, col. 22, lines 36-39, and col. 37, lines 47-52,

the "...with indicia that indicates..." is taught by Hunter at col. 6, lines 58-59,

and the that said weight of importance input field is for receiving the weight..." is taught by Onishi at col. 22, lines 36-39, col. 37, lines 47-52, and col. 3, lines 12-14.

Allowable Subject Matter

31. Claims 54, 67, 79, and 92 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

32. Applicants' arguments filed 8 November 2005 have been fully considered but they are not persuasive. In the first argument for independent claims 98 and 101 on page 12, paragraph 6, page 13, paragraphs 1-3, and page 14, paragraphs 1 and 2 the Applicants state:

"Regarding the first reason, the MPEP clearly states that statements made in the preamble of a claim "must be evaluated to determine whether the recited purpose or intended use [recited in the preamble] results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim." MPEP § 2111.02 (emphasis added). In the present case, the preamble of claim 98 recites that the claim is directed to a method "of analyzing a group of documents" that includes the various steps recited in the body of claim 98. (It is noted that the effect of the preamble of claim 101 is similar to the effect of the preamble of claim 98, even though it is in Beauregard format.)

Art Unit: 2168

To illustrate how the Office Action fails to properly treat the preamble as important to the claim, in rejecting claim 98, the Office Action parses the claim limitation of "reviewing each of said plurality of patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents" into the following three phrases: 1) "retrieving a plurality of patent documents from a first database;" 2) "so as to determine for each of said plurality of patent documents;" and 3) "a problem solved by said at least one invention corresponding to that one of said plurality of patent documents" Office Action, pp. 2-3. The Office Action then states that Hunter et al.: disclose the subject matter of the first phrase at col. 17, lines 50-52 and col. 1, lines 16-20; disclose the subject matter of the second phrase at col. 13, lines 28-30 and col. 1, lines 16-20; and disclose the subject matter of the third phrase at col. 15, lines 34-40, col. 19, lines 59-61, col. 16 lines 17-21, and col. 1, lines 16-20.

First, Applicants point out that the citation to col. 1, lines 16-20 appears completely nonsensical in the context of the three phrases. Col. 1, lines 16-20 of the Hunter et al. patent read in their entirety: "The copyright owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure as it appears in the Patent and Trademark Office patent files or records, but otherwise reserves all copyrights whatsoever." Applicants fail to see how this statement regarding copyrights in the Hunter et al. patent disclosure discloses or suggests any one of the three above-quoted phrases, let alone all of them. Discounting, then, the citations to col. 1, lines 16-20, the remaining pinpoint citations are directed to aspects of the Hunter et al. expert system that are unrelated to one another and that certainly do not disclose or suggest, separately or together, the limitation of claim 98 of "reviewing each of said plurality of patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents."

Consequently, in the context of the three parsed phrases of claim 98 Quoted above, the preamble of claim 98 indeed provides a "manipulative difference" between the claim limitation in its proper entirety, i.e., "reviewing each of said plurality of patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents," and the three wholly unrelated aspects of the Hunter et al. expert system that the Office Action asserts discloses this limitation. Essentially, this manipulative difference is that the just-quoted limitation must be examined as a whole, rather than being parsed into arbitrary component parts. Since the preamble indeed provides a manipulative difference between claim 98 and the Hunter et al. patent, as MPEP § 2111.02 counsels, the preamble of claim 98 is indeed a limitation of the claim. When each of claims 98 and 101 are considered in light of their preambles, i.e., each of the limitations of these claims are examined without improperly parsing the limitations, it is clear that the Office Action's rejection of these claims that simply grafts together unrelated concepts in attempt to reconstruct individual claim limitations is improper."

Art Unit: 2168

The Examiner disagrees. Applicant's arguments with respect to claims 98 and 101 have been considered but are moot in view of the new ground(s) of rejection. The Rivette reference has been added to the Hunter reference to provide a rejection under 35 U.S.C. ¶ 103(a). Rivette teaches the first two limitations cited in page 13, paragraph 2 by "retrieving a plurality of patent documents from a first database" at col. 25, lines 47-50 and "so as to determine for each of said plurality of patent documents" at col. 107, lines 13-18 and col. 25, lines 47-50. The third limitation in that paragraph is taught by a combination of Rivette and Hunter references by: Hunter teaches "a problem solved by said at least one invention" at col. 13, lines 21-25 and Rivette teaches "corresponding to that one of said plurality of patent documents" at col. 25, lines 47-50.

33. In the second argument for independent claims 98 and 101 on page 14, paragraphs 3 and 4 and page 15, paragraphs 1 and 2 the Applicants state:

"As mentioned above, the present rejection is also improper because the Office Action has failed to consider the claimed invention as a whole, as taught by MPEP § 2141.02. When members of the U.S. Patent and Trademark Office's examining corps examine claims, they must consider each claimed invention as a whole. One result of this is that the examining corps must find teachings in the references it applies in rejecting claims that address each and every limitation of the claims. Each claim limitation must be found either in its entirety or as a logical, coherent combination of parts. In the present case, relative to claim 98, the examining corps must find a reference that teaches in a coherent exposition the step of "reviewing each of said plurality of patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents." It should be manifestly evident that this limitation cannot logically be parsed into components. For example, the phrase of this limitation "so as to" means that the part appearing after this phrase, i.e., "determine . . . a problem solved" is an immediate result of the part appearing before the phrase, i.e., "reviewing each of said plurality of patent documents" Consequently, to parse this coherent limitation into multiple parts, to find disparate support for these parts, and to reconstruct the entire limitation from such disparate support is not only a violation of proper examining procedures as set forth in the MPEP and U.S. case law, but it is nonsensical. To illustrate how this is nonsensical, the approach of systematically parsing limitations in

Art Unit: 2168

the manner of the present Office Action can be taken to the absurd extreme by parsing each limitation into individual words and asserting that the claim is anticipated by a dictionary because each of the words is found in that dictionary, even though the words are unrelated and out of context relative to any of the limitations and the claim as a whole. The present rejection, of course, does not go that far. Nevertheless, the parsing approach used in the rejection bears some relation to this extreme example.

Because the present anticipation rejection is improper for at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the present rejection of claims 98 and 101. If the Examiner continues the rejection, Applicants respectfully request that the Examiner address how the rejection takes into consideration the preamble of the claims and the claims as a whole. In particular, Applicants request that the Examiner address how it is proper to assert that a reference teaches a claim limitation when the asserted limitation is merely an incongruous reconstruction of disparate subject matter taken from multiple locations and out of multiple contexts that are not only disparate from each other but are also unrelated to the context of the claim limitation.

The Examiner disagrees. Applicant's arguments with respect to claims 98 and 101 have been considered but are moot in view of the new ground(s) of rejection. The Rivette reference has been added to the Hunter reference to provide a rejection under 35 U.S.C. ¶ 103(a). The Applicants have requested further clarification on the rejection of the limitation "reviewing each of said plurality of patent documents so as to determine for each of said plurality of patent documents a problem solved by said at least one invention corresponding to that one of said plurality of patent documents." This limitation is taught by a combination of Rivette and Hunter references by: Rivette teaches "reviewing each of said plurality of patent documents" at col. 108, lines 30-32 and col. 25, lines 47-50, "so as to determine for each of said plurality of patent documents" at col. 107, lines 13-18 and col. 25, lines 47-50, and "corresponding to that one of said plurality of patent documents" at col. 25, lines 47-50 and Hunter teaches "a problem solved by said at least one invention" at col. 13, lines 21-25. Rivette teaches "reviewing each of said plurality of patent documents" as follows:

Art Unit: 2168

"...In step 10412, the operator **reviews** the **patent citation report** to identify a competitor's potential future product direction..." at col. 108, lines 30-32.

"...As just noted, the **document** storage and **retrieval** module 408 operates to access data in the **document databases** 612, such as the customer's repository of patents represented by the **patent database** 614..." at col. 26, lines 47-50.

In the first citation (at col. 108, lines 30-32) Rivette teaches the review of the patent citation report, which is derived from the patent citations on the front page of a patent.

This would constitute in itself a review of patent documents. This is modified by the second citation (at col. 26, lines 30-32), which explicitly identifies the patent database as a document database that contains patent documents. The combination of these two citations quite adequately teaches the portion of the limitation "reviewing each of said plurality of patent documents".

34. In the third argument for independent claims 50, 63, 75, and 87 on page 17, paragraph 5 and page 18, paragraphs 1-3 the Applicants state:

"The limitation at issue in item 31 is "developing a set of search arguments relating to one or more interests of a user." (Emphasis added.) The Examiner asserts that Dunworth et al. teach this limitation because the Dunworth et al. Web organizer "translates" a menu selection into either a set of search engine queries or a set of Web destinations. It appears the Examiner is using the word "causing" in place of the claim word "developing" based on the (false) justification that a thesaurus cites these words as being synonyms. Applicants respectfully disagree with this substitution.

The Examiner is respectfully reminded that in construing claim terminology, the U.S. Patent and Trademark Office affords claim terminology its broadest reasonable interpretation

that is "consistent with the interpretation that those skilled in the art would reach." MPEP § 2111 (*citing In re Cartright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)). Thus, an examiner is not free to simply apply the broadest interpretation of claim terminology, but rather the examiner must adjust the breadth of the terminology to the breadth that those skilled in the art would give the terminology "taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in the applicant's specification." *Id.* (*citing In re*

Art Unit: 2168

Morris. 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) [emphasis added]).

In the present case, it is Applicants' position that those skilled in the art, having reviewed and understood the present application, would recognize that the word "developing" does not mean "causing," but rather has a meaning more akin to the definition cited by Applicants. This is so because the present application describes at page 8 *et seq.* that the developing of search arguments flows from a user using an input form to define search arguments. This description does not describe the developing in terms of causation, but rather in terms of transforming from an undeveloped state to a developed state. This is a much different concept than mere causation. Again, Dunworth et al. do not disclose or suggest "developing a set of search arguments" as required by claim 50. [Emphasis added.] Regarding the use of a thesaurus to support the Examiner's substitution, dictionaries and thesauruses cannot be used in a manner that ignores the meaning that would be ascribed by those skilled in the art."

The Examiner disagrees. Applicant's arguments with respect to claims 50, 63, 75, and 87 have been considered but are moot in view of the new ground(s) of rejection. The

Dunworth and Liddy references have been replaced by the Rivette and Paulsen

references. Paulsen teaches the building (developing) of search arguments as follows:

"...This is done by including all the returned documents and building what amounts to a "super signature" of all the selected documents; then the most frequently occurring words are used in that "super document" to **build** the new **search argument**..." at col. 15, lines 2-6.

The term "build" clearly translates into the term "develop". If one search argument is developed a set of search arguments may likewise be developed. The citation (col. 15, lines 2-6) when combined with Paulsen's teaching at col. 9, lines 33-37 fully teaches the development of a set of search arguments.

35. In the fourth argument for independent claims 50, 63, 75, and 87 on page 19, paragraphs 2 and 3 the Applicants state:

"Claim 50, for example, requires the steps of "developing a set of search arguments relating to one or more interests of a user" and "developing a set of user-defined fields relating to said one or more interests." [Emphasis added.] In these steps, it is clear to

Art Unit: 2168

those skilled in the art that the user in the first quoted phrase is the one having one or more interests and is also the one that defines the "user-defined" fields. [Emphasis added.) This is the only reasonable interpretation of the two above-quoted steps of claim 50.

In contrast, in the Dunworth et al. Web organizer, it would be the end-users that have the one or more interests, yet it is the publisher that defines the fields. In other words, Dunworth et al. disclose two different types of users, i.e., end-users and publisher-users. The result is that Dunworth et al. do not disclose "user-defined" fields as contemplated by claim 50. In claim 50, a user-defined field is one that the user having the one or more interests defines. Dunworth et al. are completely silent on providing its end-users with any user-defined fields. Rather, the Dunworth et al. fields are publisher-defined fields. This distinction cannot be ignored in rejecting the present claims, since the claims are explicit on the point that the user-defined fields correspond to the same users that have the one or more interests. Therefore, Dunworth et al. are completely silent on the limitation of "developing a set of user-defined fields" as required by claims 50, 63, 75, and 87."

The Examiner disagrees. Applicant's arguments with respect to claims 50, 63, 75, and 87 have been considered but are moot in view of the new ground(s) of rejection. The Dunworth and Liddy references have been replaced by the Rivette and Paulsen references. Rivette explicitly teaches the developing of user-defined fields as follows:

"...Operators can extend the bibliographic databases 602 in patent-centric ways. For example, a "current licensee" field can be added to the patent bibliographic databases 604. This could be accomplished, for example, by **defining** one of the **user defined fields** to be a current licensee field..." at col.19, lines 26-29.

Rivette clearly teaches the developing of user-defined fields.

36. In the fifth argument for independent claims 50, 63, 75, and 87 on page 19, paragraph 5 and page 20, paragraphs 1-3 the Applicants state:

"Regarding the former issue, as discussed above relative to item 32, the publisher-defined fields are not equivalent to the user-defined fields of the present claims. Consequently, field values input by a publisher are not user-defined field values as contemplated by the present claims. Regarding the latter issue. Applicants again assert that the examining corps is improperly parsing limitations into phrases without regard to the claimed invention as a whole and without regard to the context-imparting preamble.

Art Unit: 2168

That is, the examining corps is improperly back-fitting (of course using an improper amount of hindsight of the present claims) a number of unrelated concepts to reject an entire limitation. Again, this is as nonsensical as rejecting the claims based on a dictionary because the dictionary contains all of the words in the claims. (Since this is an obviousness-type rejection, the more appropriate analogy would be to reject the claims based on two or more dictionaries that together contain all of the words of the claims.)

Upon reviewing the references as a whole, it is clear that the combination does not disclose or suggest the entire limitation of claim 50 of "reading each of said plurality of retrieved documents from among the plurality of documents so as to extract from each of said plurality of retrieved documents a user-defined fields value" in the context of "researching and analyzing information contained in a plurality of documents belonging to a first database, searchable on a plurality of search fields and having a plurality of search field values" as required by the preamble of claim 50."

The Examiner disagrees. Applicant's arguments with respect to claims 50, 63, 75, and 87 have been considered but are moot in view of the new ground(s) of rejection. The Dunworth and Liddy references have been replaced by the Rivette and Paulsen references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The response to the fourth argument has already addressed the issue of user-defined fields. Any value input by a user in a user-defined field would be a user-defined field value.

37. In the sixth argument for independent claims 50, 63, 75, and 87 and dependent claims 58-62 on page 20, paragraph 5 and page 21, paragraph 1 the Applicants state:

"Regarding the first issue, the Dunworth et al. Web organizer is not user-modifiable in the sense contemplated by the claims and the sense that would be understood by those skilled in the art. As discussed above, "user-modifiable" in the context of the present

Art Unit: 2168

claims means that the end-user of the Dunworth et al. organizer would be able to modify the organizer. This simply is not true. Publishers are not end-users. (See the discussion above regarding item 32.) Rather, publishers set up the organizer for use by end-users. Regarding the second issue, clearly claims 50, 63, 75, and 87 include the steps of "entering said plurality of user-defined values" and "entering the ones of the plurality of search field values" into a second database, which are directed to populating a database. In this connection, the Examiner asserts that claims 58-62 are directed to populating databases. This, too, is not so. Claims 58-62 are directed to populating input forms. Here, too, the examining corps is improperly picking and choosing excerpts from references without any regard to the claimed invention as a whole and to the limiting function of the preamble."

The Examiner disagrees. Applicant's arguments with respect to claims 50, 58-62, 63, 75, and 87 have been considered but are moot in view of the new ground(s) of rejection.

The Dunworth and Liddy references have been replaced by the Rivette and Paulsen references. The issue of user-developed fields is addressed in the response to the fourth argument. Rivette teaches the entry of values into fields by users at col. 117, lines 61-67 and col. 118, lines 1-3. Any value entered into a field by a user is a user-defined value. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

38. In the seventh argument for claims 51, 55, 56, 64, 68, 69, 76, 80, 81, 89, 93, and 94 on page 21, paragraph 3 the Applicants state:

"For the reasons discussed above relative to claims 50, 63, 75, and 87, claims 50, 63, 75, and 87 are not obvious. Therefore, claims 51, 55, 56, 64, 68, 69, 76, 80, 81, 89, 93, and 94 are not obvious. In addition, claims 55, 56, 68, 69, 80, 81, 93, and 94 are not obvious because neither the Dunworth et al. nor Liddy et al. patents disclose or suggest user-defined fields, nor weights associated with such fields."

Art Unit: 2168

The Examiner disagrees. Applicant's arguments with respect to claims 51, 55, 56, 64, 68, 69, 76, 80, 81, 89, 93, and 94 have been considered but are moot in view of the new ground(s) of rejection. The Dunworth and Liddy references have been replaced by the Rivette and Paulsen references. Rivette teaches the use of "counts", which are used to define a frequency of named inventors. A weight is simply a measure of a count and therefore the term "count" may be used to suggest the word "weight". Since the responses to the third through the sixth arguments have shown that independent claims 50, 63, 75, and 87 are rendered obvious, claims 51, 55, and 56 depend on independent claim 50, claims 64, 68, and 69 depend on independent claim 63, claims 76, 80, and 81 depend on independent claim 75, claims 89, 93, and 94 depend on independent claim 87, and the term "count" may be used to suggest the word "weight" then claims 51, 55, 56, 64, 68, 69, 76, 80, 81, 89, 93, and 94 are still rendered obvious.

39. In the eighth argument for claims 57, 70, 82, and 95 on page 21, paragraphs 5 and 6 and page 22, paragraphs 1 and 2 the Applicants state:

"First, these claims are not obvious because the claims from which they depend are not obvious for the reasons discussed above. Second, Applicants reiterate the arguments from the 5/11/05 Response because Applicants believe they are still proper. In this connection, it is clear from the Examiner's comments that the Examiner misinterpreted Applicants' argument on page 16, paragraphs 5 and 6 and page 17, paragraph 1, of the 5/11/05 Response. In item 37, it appears that the Examiner believes that Applicants' argument was that Liddy et al. teach summing subject field codes, which are labels. This is not so. Applicants' prior argument is as follows. It clearly does not suggest that labels are summed.

In rejecting claims 55, 68, 80 and 93, the Examiner asserts that Liddy et al. disclose the "weights" limitation of these claims at col. 5, lines 10-11. The weights disclosed at this passage are weights corresponding to subject fields codes, which are derived from summing occurrences of words for each subject field code. The subject code weights are contained in the subject code vector and are not summed. Rather, it is the word occurrences that are summed, as described at col. 9, lines 20-26. Applicants assert that the Examiner is improperly applying the word summation techniques described at col. 9,

Art Unit: 2168

lines 20-26 to the weights disclosed at col. 5, lines 10-11. Applicants believe that these two passages describe concepts that are separate and distinct from one another and, as such, cannot reasonably be combined as the Examiner has done in rejecting these claims. Since neither the Liddy et al. patent nor Dunworth et al. patent disclose the weight tallying limitation of claims 57, 70, 82 and 95, the combination of these two patents cannot render these claims obvious.

5/11/05 Response, p. 16, ln. 28 to p. 17, ln. 10. Generally, this excerpt asserts that the Liddy et al. word summation techniques are not analogous to the assignment of weights as claimed in the rejected claims. Again, Applicants assert that the examining corps is simply picking and choosing disclosures that are, perhaps, somewhat related to concepts expressed in the claims. However, the rejection ignores the basic claim examining tenets of considering claimed invention as a whole and considering the contextual effect of the preamble.

The Examiner disagrees. Applicant's arguments with respect to claims 57, 70, 82, and 95 have been considered but are moot in view of the new ground(s) of rejection. The Dunworth and Liddy references have been replaced by the Rivette and Paulsen references. Rivette teaches the use of "counts", which are used to define a frequency of named inventors. A weight is simply a measure of a count and therefore the term "count" may be used to suggest the term "tallying of weights". The tallying of weights is in fact equivalent to the sequential counting of the occurrences of items such as the frequency of named inventors in a set of retrieved patent documents. Since the responses to the third through the sixth arguments have shown that independent claims 50, 63, 75, and 87 are rendered obvious, 57, 70, 82, and 95 depend on independent claims 50, 63, 75, and 87, respectively, and the term "count" may be used to suggest the term "tallying of weights" then claims 57, 70, 82, and 95 are still rendered obvious.

40. In the ninth argument for claims 52-54, 65-67, 77-79, and 90-92 on page 22, paragraph 4 and page 23, paragraph 1 the Applicants state:

Art Unit: 2168

"Office Action item 39 In item 39 of the present Office Action the Examiner states that Liddy et al. disclose the limitations of claims 52-54, 65-67, 77-79, and 90-92 that are directed to forming high level of abstraction clusters. Applicants respectfully disagree, Again, the examining corps is picking and choosing unrelated concepts to reject a limitation parsed into phrases each containing something that resembles the concepts chosen. In the present case, it appears that the examining corps has merely conducted word searches and located terms used in the present claims. In the present case, the relevant portion of the Chen et al. patent states "The 'Clustering Report' 2410 contains the most characteristic keywords 2412 across all documents for the user cluster. This enables quick access to a high level abstraction of this modality while simultaneously viewing other properties" Chen et al. patent, col. 8, lines 13- 17. How this teaches, e.g., the limitation of claim 52 of "forming a plurality of high level of abstraction (HLA) clusters and assigning each of said plurality of retrieved documents to one of said plurality of HLA clusters" is beyond comprehension of Applicants. The only reasonable explanation is that the examining corps is ignoring certain tenets of claim examination discussed above."

The Examiner disagrees. Applicant's arguments with respect to claims 57, 70, 82, and 95 have been considered but are moot in view of the new ground(s) of rejection. The Dunworth and Liddy references have been replaced by the Rivette and Paulsen references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Since the responses to the third through the sixth arguments have shown that independent claims 50, 63, 75, and 87 are rendered obvious, claims 52-54 depend on independent claim 50, claims 65-67 depend on independent claim 63, claims 77-79 depend on independent claim 75, claims 90-92 depend on independent claim 87, and the two court decisions cited in this response have shown that the construction of the rejection of these claims is proper then claims 52-54, 65-67, 77-79, and 90-92 are still rendered obvious.

Art Unit: 2168

41. In the tenth argument for claims 58, 60-62, 71-74, 83-86, 96, and 97 on page 23, paragraph 3 the Applicants state:

"In addition to these claims being patentable because parent claims 50, 63, 75, and 87 are patentable for the reasons discussed above, the fact that the present rejection has been made based upon an improper parsing of claim limitations into component concepts without regard to the context of the parsed limitations and the claimed invention as a whole clearly counsels that the present rejection is based upon a level of hindsight reconstruction that far exceeds the acceptable level. Applicants are aware that a certain level of hindsight reconstruction is unavoidable in examining claims. However, when the reconstruction amounts to nothing more than a culling of out-of-context references, the amount of hindsight used is certainly improper."

The Examiner disagrees. Applicant's arguments with respect to claims 58, 60-62, 71-74, 83-86, 96, and 97 have been considered but are moot in view of the new ground(s) of rejection. The Dunworth and Liddy references have been replaced by the Rivette and Paulsen references. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Since the responses to the third through the sixth arguments have shown that independent claims 50, 63, 75, and 87 are rendered obvious, claims 58 and 60-62 depend on independent claim 50, claims 71-74 depend on independent claim 63, claims 83-86 depend on independent claim 75, claims 96 and 97 depend on independent claim 87, and the two court decisions cited in this response have shown that the construction of the rejection of these claims is proper then claims 58, 60-62, 71-74, 83-86, 96, and 97 are still rendered obvious.

Art Unit: 2168

42. In the eleventh argument for claim 59 on page 23, paragraphs 5 and 6 and page 24, paragraph 1 the Applicants state:

"In support of the rejection, the Examiner states that Bollay teaches the populating of forms at col. 2, lines 51-54 and that Chen et al. teach use of known documents at col. 10, lines 21-24. Explicitly, Bollay states that "Local browser software populates a specific search form peculiar to a given remote database by utilizing the translations as embodied in JavaScript code," and Chen et al. state "It should be observed that in a presently preferred embodiment of the invention, the collection comprises all known documents that will ever be processed by a system according to the invention." Again, Applicants assert that the examining corps has: 1) improperly parsed a claim limitation, i.e., "populating said first input forma with known documents already known to the user," into components concepts, i.e., the concept of "populating an input form" and the concept of "known documents;" 2) located a reference for each of these concepts, i.e., the passages of the Bollay and Chen et al. patents quoted above, wherein the context of these concepts in the cited patents is wholly unrelated to the claim limitation at issue; and 3) reconstructed these non-contextual, unrelated concepts into the claim limitation using an improper amount of hindsight of the present claim. Applicants assert that without the present claim, it is not reasonable to assert that a person having ordinary skill in the art would arrive at the claim limitation of "populating said first input form with known documents already known to the user" from a statement that a collection comprises all known documents and a statement that software populates a search form, especially when there is not motivation or event suggestion that the search form be populated with known documents."

The Examiner disagrees. Applicant's arguments with respect to claim 59 has been considered but are moot in view of the new ground(s) of rejection. The Dunworth and Liddy references have been replaced by the Rivette and Paulsen references and Rivette teaches portion of the limitation previously taught by Chen. Rivette teaches the "known documents" concept of the limitation as follows:

"...Accordingly, by opening the folder corresponding to the repository group 11710 in the group pane 11704, the operator can view all patents that are contained in the patent repository (that is, all patents that are in the patent database 614), and, in fact, can view **all documents that are in the repository...**" at col. 115, lines 22-27.

Art Unit: 2168

Certainly, all documents that are in the repository represent the set of known documents. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Since the responses to the third through the sixth arguments have shown that independent claim 50 is rendered obvious, claim 59 depends on independent claim 50, and since Rivette teaches portion of the limitation previously taught by Chen then claim 59 is still rendered obvious.

43. In the twelfth argument for claims 99 and 102 on page 24, paragraphs 3-5 and page 25, paragraph 1 the Applicants state:

"Lautzenheiser et al. disclose a method of implementing a database and system for handling customer survey data. The system includes features for conducting strength, weakness, opportunity, and threat (aka "SWOT") analyses on the survey data. As discussed above, Hunter et al. disclose a system that aids inventors, technology managers, and patent professionals in preparing invention disclosures. As also discussed above, Hunter et al. fail to disclose or suggest, among others, the steps of claims 99 and 102 of reviewing a plurality of documents and preparing a problem solved statement for each of the documents in the context of analyzing the documents. Lautzenheiser et al. are likewise completely silent on such steps. Therefore, the applied combination cannot render claims 99 and 102 obvious. In addition, it is clear that the Examiner is using an improper amount of hindsight to make the present rejection. This is so because the overall teachings of the two patents are so different from each other that there is no reasonable motivation to combine the two. That is, it is unreasonable to say that SWOT features of Lautzenheiser et al. are combinable with the disclosure-drafting aid of Hunter et al., without using the present claims to construct a rejection."

The Examiner disagrees. Applicant's arguments with respect to claims 99 and 102 have been considered but are moot in view of the new ground(s) of rejection. The Rivette reference has been added to the Hunter reference to provide a rejection under 35

Art Unit: 2168

U.S.C. ¶ 103(a). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Rivette anticipates the use of threat and opportunity analysis by:

"Intellectual Property Analysis of patents as related to
(IP) Attorneys mapping, licensing, infringement, non-renewal, cross-licensing etc.
Technical Personnel Analysis of patents and how they relate to given product functions and features. Also domain R&D experts as needed for specific competitive technology assessment
MIS personnel Help in data extraction from operational systems
Marketing personnel Product Strategy, Features, Target Markets, Competitive Analysis
Business and Financial Analysts Economic implications, profit, loss, tax, market share, etc." at col. 17, lines 22-31.

Since the responses to the first and second arguments have shown that independent claims 98 and 101 are rendered obvious, claims 99 and 102 depend on independent claims 98 and 101 respectively, and since Rivette anticipates the use of threat and opportunity analysis then claims 99 and 102 are still rendered obvious.

44. In the thirteenth argument for claim 59 on page 25, paragraphs 2-5 and page 26, paragraph 1 the Applicants state:

"The Examiner has rejected claims 100 and 103 under 35 U.S.C. § 103 as being obvious in view of the Hunter et al. and Lautzenheiser et al. patents, discussed above,

Art Unit: 2168

and further in view of U.S. Patent No. 6,154,720 to Onishi et al., stating Hunter et al. and Lautzenheiser et al. disclose a method and computer readable medium and containing all of the limitations of these claims except for associating weights with problem-solved statements. The Examiner then asserts that Onishi et al. disclose the concepts of threat and opportunity analyses and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Onishi et al. in the method and computer readable medium disclosed by Hunter et al. and Lautzenheiser et al. Applicants respectfully disagree.

The Hunter et al. and Lautzenheiser et al. patents are as described above.

The Onishi et al. patent is directed to a language translation apparatus for translating sentences from one language into another. In one embodiment, a weight is added to each of the semantic features registered for the individual conversational sentence examples in the bilingual database, and the semantic searcher determines the degree of semantic coincidence by using the weights.

None of the applied references discloses or even suggest the steps of reviewing a plurality of documents and preparing a problem solved statement for each of the documents in the context of analyzing the documents. Therefore, the applied combination cannot render claims 100 and 103 obvious.

Furthermore, the present rejection is clearly made using an improper amount of hindsight reconstruction of the claims. Again, the rejection includes snippets from disparate and unrelated references that are combined ad hoc so as to reject the claims. In summary, none of the references cited by the Examiner disclose or suggest the combination of elements present in the claims under consideration. The only motivation for the combination is pure hindsight of the claims."

The Examiner disagrees. Lautzenheiser is not used to render obvious claims 100 and 103. Applicant's arguments with respect to claims 100 and 103 have been considered but are moot in view of the new ground(s) of rejection. The Rivette reference has been added to the Hunter reference to provide a rejection under 35 U.S.C. ¶ 103(a). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

Art Unit: 2168

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Rivette anticipates the use of weights of importance by teaching the use of "counts", which are used to define a frequency of named inventors. Since the responses to the first and second arguments have shown that independent claims 98 and 101 are rendered obvious, since claims 100 and 103 depend on independent claims 98 and 101 respectively, and since Rivette anticipates the use of weights of importance then claims 100 and 103 are still rendered obvious.

Conclusion

45. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harold E. Dodds, Jr. whose telephone number is (571)-272-4110. The examiner can normally be reached on Monday - Friday 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2168

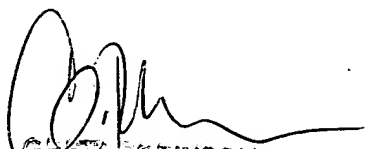
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Harold E. Dodds, Jr.

Harold E. Dodds, Jr.

Patent Examiner

March 20, 2006


G. STAROBIN
PRIMARY EXAMINER